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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,299	12/08/2003	Srikanth Karimisetty	021756-005200US	3624
51206 7590 11/26/2007 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER PATEL, NIRAV B	
			ART UNIT 2135	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/731,299

Applicant(s)

KARIMISSETTY ET AL.

Examiner

Nirav Patel

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/18, 7/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed on Sep. 18, 2007 has been entered. Claims 1-25 are pending. Claims 1, 11, 17-25 are amended by the applicant.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-25 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/731655. Although the conflicting claims are not identical, they are not patentably distinct from the each other because both use a rule associated with the record to determine whether an electronic signature is required.

Claims 1-25 of the instant application contain every element of claims 1-26 of copending Application No. 10/731655 and thus anticipate the claims of the instant

application. Claims of the instant application therefore are not patently distinct from the earlier co-pending claims and as such are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is **anticipated by**, the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a 35 patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "**anticipated**" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected

under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 10-12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) and in view of Alley et al (US Pub. No. 2003/0078880).

As per claim 1, Nishizawa teaches:

automatically creating an electronic record from data stored in a plurality of different database tables in response to an occurrence of a predetermined event [Fig. 2, 3, paragraph 0025 lines 3-11, 0088-0090, 0117, 0118]; storing an instance of the

electronic record in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of associated with the database [Fig. 2, paragraph 0100, Fig. 7].

Nishizawa teaches the electronic record with an electronic signature [paragraph 0127]. Nishizawa doesn't expressively mention a rule associated with the electronic record to determine whether an electronic signature is required.

Spitz teaches executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record [col. 3 lines 31-38 col. 6 lines 60-67]; and if execution of the rule results in a determination that an electronic signature is required, initiating a request to collect the required electronic signature [col. 6 lines 15-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Spitz with Nishizawa, since one would have been motivated to obtain a digital signature [Spitz, col. 1 lines 6-8].

Nishizawa and Spitz do not expressively mention marking the instance of the electronic record as unsigned.

Alley teaches marking the instance of the electronic record as unsigned [Fig. 3, paragraph 0090 lines 16-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alley with Nishizawa and Spitz, since one would

have been motivated to provide a electronic signature and manage the digital documents [Alley, paragraph 0014].

As per claim 10, the rejection of claim 1 is incorporated and Alley teaches the electronic record is initially marked as unsigned by setting an appropriate attribute associated with a database table in which at least part of the record is stored [Fig. 3, 6].

As per claim 11, it encompasses limitations that are similar to those of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 12, the rejection of claim 11 is incorporated and Nishizawa teaches the electronic record is stored in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of the database [Fig. 2, paragraph 0131, 0132].

As per claim 18, it encompasses limitations that are similar to those of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 19, the rejection of claim 18 is incorporated and it encompasses limitations that are similar to limitations of claim 3. Thus, it is rejected with the same rationale applied against claim 3 above.

4. Claims 2, 3, 7, 16, 17, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of in view of Hawkins et al (US Patent No. 7,146,500).

As per claim 2, the rejection of claim 1 is incorporated and Alley teaches receiving an electronic signature from the user and marking the instance of the electronic record as signed [Fig. 3, 0090].

Alley doesn't expressively mention verifying the electronic signature.

Hawakins teaches receiving an electronic signature from the user; verifying the electronic signature and in response to a positive verification of the electronic signature, adding the signature [Fig. 3, col. 5 lines 50-65].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hawakins with Nishizawa, Spitz and Alley, since one would have been motivated to provide secure environment and safe storage for storing the electronic record [Hawakins, col. 1 lines 8-9].

As per claim 3, the rejection of claim 2 is incorporated and Nishizawa teaches the electronic record is stored in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of the database [Fig. 2, paragraph 0131, 0132].

As per claim 7, the rejection of claim 1 is incorporated and Spitz teaches execution of the rules results in a determination that an electronic signature is required [col. 6 lines 60-67].

Hawkins teaches:

if an electronic signature is required, displaying data from the electronic record on a computer display [col. 7 lines 21-34].

As per claim 16, the rejection of claim 11 is incorporated and it encompasses limitations that are similar to limitations of claim 2. Thus, it is rejected with the same rationale applied against claim 2 above.

As per claim 17, the rejection of claim 16 is incorporated and Alley teaches the electronic record is initially marked as unsigned by setting an appropriate attribute associated with a database table in which at least part of the record is stored [Fig. 3, 6].

As per claim 23, the rejection of claim 18 is incorporated and it encompasses limitations that are similar to limitations of claim 2. Thus, it is rejected with the same rationale applied against claim 2 above.

As per claim 24, the rejection of claim 23 is incorporated and it encompasses limitations that are similar to limitations of claim 17. Thus, it is rejected with the same rationale applied against claim 17 above.

5. Claims 4-6, 13-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of Chang et al (US Patent No. 6,584,459).

As per claim 4, the rejection of claim 1 is incorporated and Nishizawa teaches the electronic record comprises unstructured data [paragraph 0016, 0017].

Nishizawa doesn't expressively mention a character large object (CLOB) format.

Chang teaches unstructured data in a character large object (CLOB) format [Fig. 3].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Chang with Nishizawa, Spitz and Alley, since one would have been motivated to manage and store the digital documents [Alley, paragraph 0014].

As per claim 5, the rejection of claim 1 is incorporated and Chang teaches the unstructured data comprises a well-formed XML document stored within a column of a table stored in the database [Fig. 3].

As per claim 6, the rejection of claim 1 is incorporated and Nishizawa teaches:

fields of the electronic record are filled with XML data based on a predefined mapping to multiple data sources [paragraph 0117, 0118, Fig. 4, 9].

As per claim 13, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 4. Thus, it is rejected with the same rationale applied against claim 4 above.

As per claim 14, the rejection of claim 13 is incorporated and it encompasses limitations that are similar to limitations of claim 5. Thus, it is rejected with the same rationale applied against claim 5 above.

As per claim 15, the rejection of claim 14 is incorporated and it encompasses limitations that are similar to limitations of claim 6. Thus, it is rejected with the same rationale applied against claim 6 above.

As per claim 20, the rejection of claim 19 is incorporated and it encompasses limitations that are similar to limitations of claim 4. Thus, it is rejected with the same rationale applied against claim 4 above.

As per claim 21, the rejection of claim 20 is incorporated and it encompasses limitations that are similar to limitations of claim 5. Thus, it is rejected with the same rationale applied against claim 5 above.

As per claim 22, the rejection of claim 21 is incorporated and it encompasses limitations that are similar to limitations of claim 6. Thus, it is rejected with the same rationale applied against claim 6 above.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of Hawkins et al (US Patent No. 7,146,500) and in view of Kato et al (US Pub. 2002/0040431).

As per claim 8, the rejection of claim 7 is incorporated and Nishizawa teaches the electronic record comprises the XML document [Fig. 9].

Kato teaches data from the electronic record is display according to a predefined layout set forth in an XSL style sheet [paragraph 0077].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Chang with Nishizawa, Spitz and Alley, since one would have been motivated to provide secure environment and safe storage for storing the electronic record [Hawakins, col. 1 lines 8-9].

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of Hopkins et al (US Patent No. 7,093,133).

As per claim 9, the rejection of claim 1 is incorporated and Hopkins teaches:

The rule requires a plurality of different electronic signatures and wherein, if execution of the rule results in a determination that a plurality of electronic signatures are required, requesting the plurality of electronic signatures [col. 2 lines 30-38].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hopkins with Nishizawa, Spitz and Alley, since one would have been motivated to provide a reliable and secure means of authenticating digital messages/records [Hopkins, col. 2 lines 22-23].

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No.

7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) in view of in view of Hawkins et al (US Patent No. 7,146,500) and view of in view of Chang et al (US Patent No. 6,584,459).

As per claim 25, Nishizawa teaches:

automatically creating an electronic record from data stored in a plurality of different database tables in response to an occurrence of a predetermined event [Fig. 2, 3, paragraph 0025 lines 3-11, 0088-0090, 0117, 0118]; storing an instance of the electronic record in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of associated with the database [Fig. 2, paragraph 0100, Fig. 7].

Nishizawa teaches the electronic record with an electronic signature [paragraph 0127]. Nishizawa doesn't expressively mention a rule associated with the electronic record to determine whether an electronic signature is required.

Spitz teaches executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record [col. 3 lines 31-38 col. 6 lines 60-67]; and if execution of the rule results in a determination that an electronic signature is required, initiating a request to collect the required electronic signature [col. 6 lines 15-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Spitz with Nishizawa, since one would have been motivated to obtain a digital signature [Spitz, col. 1 lines 6-8].

Nishizawa and Spitz do not expressively mention marking the instance of the electronic record as unsigned.

Alley teaches marking the instance of the electronic record as unsigned [Fig. 3, paragraph 0090 lines 16-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alley with Nishizawa and Spitz, since one would have been motivated to provide a electronic signature and manage the digital documents [Alley, paragraph 0014].

Alley teaches receiving an electronic signature from the user and marking the instance of the electronic record as signed [Fig. 3, 0090].

Alley doesn't expressively mention verifying the electronic signature.

Hawakins teaches receiving an electronic signature from the user; verifying the electronic signature and in response to a positive verification of the electronic signature, adding the signature [Fig. 3, col. 5 lines 50-65].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hawakins with Nishizawa, Spitz and Alley, since

one would have been motivated to provide secure environment and safe storage for storing the electronic record [Hawakins, col. 1 lines 8-9].

Nishizawa teaches the electronic record comprises unstructured data [paragraph 0016, 0017]. Nishizawa doesn't expressively mention a character large object (CLOB) format.

Chang teaches unstructured well-formed XML data stored in a character large object (CLOB) format [Fig. 3].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Chang with Nishizawa, Spitz and Alley, since one would have been motivated to manage and store the digital documents [Alley, paragraph 0014].

Response to Argument

9. Applicant's arguments filed Sep. 18, 2007 have been fully considered but they are not persuasive.

Examiner acknowledges the applicant's remark regarding the double patent rejection, however the double patenting rejection presented in the office action will only be withdrawn upon the submission of terminal disclaimer. Therefore, the double patenting rejection still maintains above.

Regarding to the applicant's arguments that Nashizawa, Spitz and Alley either individually or in combination, fail to teach or suggest each and every claim limitation recited in claim 1.

Examiner disagrees with the applicant for above argument, since Nashizawa's invention relates to manage an electronic file for authorizing the electronic file is authorized file, wherein a document management system for managing an electronic file and a document history management system for managing the history of an electronic file in connection with the document managing system as shown in Fig. 2. The file storing medium is a storage part whereto electronic files f1, f2 etc. which have been sent from an user terminal are stored in readable state. The document management system contains a step of determining a summarized value for the input electronic file upon an input of the electronic file into the document management system and retains the obtained summarized value in the document management system. The hash value obtaining function obtains a hash value (a summarized value for an electronic file) for an electronic file f registered by user terminal and transmits the hash value as "New registration" in XML document form together with other file information to the document history management system as shown in Fig. 2, 4 (i.e. automatically creating an electronic record from data stored in a plurality of different database tables in response to the occurrence of a predetermined event and storing an instance of the electronic record in a common repository of electronic records"). Further, as shown in Fig. 7, the user terminal designates the electronic file for confirming the original entity by user's operation and then sends the confirmation request for the original entity to the

document management system. The document management system reads out the electronic file *f* corresponding to the ID indicated in the certificate *C* by employing the hash value comparing function from the file storage medium 11, compares the both hash value calculated out of the electronic file *f* and in the certificate *C*, thereby determining the conformity of both hash values. The user terminal displays the returned certificate *C* and allows the user to confirm the original entity of the electronic file. The hash value and the historical information can be visibly confirmed by the users as a XML document and therefore, the users can easily confirm the original entity of the electronic file (i.e....electronic records that provide an audit trail that cannot be altered or disabled by users associated with the database). Therefore, Nashizawa teaches the claim limitation "automatically creating an electronic record from data stored in a plurality of different database tables in response to the occurrence of a predetermined event" and "storing an instance of the electronic record in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of the system". Further, Nashizawa teaches adding signature in a XML document form. Spitz's invention relates to obtain digital signature for the document (a XML document) using rules that identify documents authorized users are allowed to have electronically signed. The signing system parses the document to be signed and compares information obtained thereby to the rules stored in the database to determine whether the authorized user is authorized to have the document signed. Signing system includes a signing policy database which defines the type and/or attributes of the documents that each authorized person is allowed to have signed. A requestor prepares a request for a

document to be signed and the signing system sign those documents which the requester is authorized to have signed. The signing policy database include information identifying other document types and attributes (e.g. to review, approval, etc.) [col. 7 lines 9-27, col. 6 lines 60-67]. Therefore, Spitz teaches the claim limitation "executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record and if execution of the rule results in a determination that an electronic signature is required, initiating a request to collect the required electronic signature". Further, Alley's invention relates to sing/process the electronic documents and manage the electronic signing. The method involves embedding in the digital document an information block identifying a database record in a central database. The modified document is transmitted to a document signing terminal. A user at the document signing terminal indicates a request to apply signature to the document, where it is determined whether the user of the signing terminal is permitted to sign the document and if the constraint is satisfied, the document is signed. The document information block or blocks that are generated involves embedding this information block into the digital document file. The information block or blocks are encoded such as into an XML data block. The document list indicates both signed and unsigned document as shown in Fig. 3. As shown in Figs. 3-5, user interface presented to a user where the user selects the document for preparation and identifies permitted signers (i.e. creating the request to collect the required electronic signature). The central file server stores the document, updates the records associated with the received document and provides a copy of the document to

the authorized user. Therefore, Alley teaches claim limitation "marking the instance of the electronic record as unsigned and initiating a request to collect the required electronic signature". Therefore, the combination of Nashizawa, Spitz and Alley teaches the claim limitation. Further, the examiner recognizes that obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ 2nd 1941 (Fed. Cir 1992). It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with the applicant was concerned, in order to be relied upon as basis for rejection of the claimed invention. See *In re Ortiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the combination of Nashizawa, Spitz and Alley is sufficient.

The Applicant is reminded that additional modification to clarify the claimed language is necessary for further consideration and distinction from the prior art.

For the above reasons, it is believed that the rejections should be sustained.

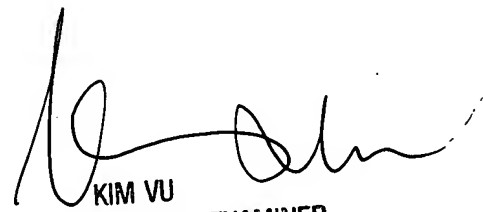
Conclusion

10. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirav Patel whose telephone number is 571-272-5936. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

NBP
11/16/07


KIM VU
PATENT EXAMINER
TECHNOLOGY CENTER 2100